Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES B. COFFEY

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Appeal No. 2002-1143
Application No. 09/085,933

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ON BRIEF

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Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-11 and 19-27, all the claims pending in the application. Subsequent to the final rejection, the examiner reconsidered the rejection of claims 1-11, 19, 20, 22-25 and 27 and indicated at pages 2-3 of the answer that these claims were either allowed or would be allowed if rewritten in independent form.

Hence, only the rejection of claims 21 and 26 remains before us for review.

Appellant's invention pertains to a segmented core around which a slit paper sheet may be wound to form wound rolls. An understanding of the subject matter remaining at issue in this appeal can be derived from a reading of claims 21 and 26, which read as follows:

21. A core comprising a tubular wall having an inner surface defining a bore, and an outer surface interrupted axially by an annular slot extending radially inwardly to an integral web for defining a plurality of core segments.

26. A core according to claim 21 wherein said web is thinner than said slot is deep.

The sole reference cited against these claims in the final rejection is:[1]

Shiba et al. (Shiba)	5,421,259	Jun. 6, 1995

The following references are cited by this merits panel in support of new rejections made pursuant to 37 CFR § 1.196(b):

Dow	176,171	Apr. 18, 1876
King	3,835,615	Sep. 17, 1974
Graham	4,730,510	Mar. 15, 1988
Folden	5,221,267	Jun. 22, 1993
Neuhauser et al. (Neuhauser)	5,431,191	Jul. 11, 1995

[1]The examiner's answer also lists U.S. Patent 3,803,959 to Rung as a reference relied upon; however, Rung was applied only in the rejection of claims 1-11, which rejection has not been maintained in this appeal.

Reference is made to appellant's main and reply briefs (Paper Nos. 16 and 19) and to the examiner's answer (Paper No. 17) for the respective positions of appellant and the examiner regarding the merits of this rejection.

Discussion

With reference of Figures 4 and 8, Shiba pertains to a guide roller for a printing press comprising a series of larger diameter peripheral portions 103 and smaller diameter peripheral portions 104 arranged in alternating fashion along the length of the roller. As we understand it, it is the examiner's position (answer, page 5) that it would have been obvious to form the roller of Shiba as an integral structure, and thereby arrive at the subject matter of claim 21.[2]

Among the points of arguments raised by appellant[3] in the main and reply briefs is the argument that the smaller diameter portions 104 of Shiba alternately provided between the larger diameter portions 103 do not constitutes annular slots. We find this argument to be persuasive. From our perspective, one of ordinary

[2]It appears to us that Shiba discloses that the roller may be formed as an integral structure (see column 9, line 63, through column 10, line 4, of Shiba), a position that appellant seems to agree with (reply brief, page 11, third full paragraph).

[3]See, for example, page 8, lines 1-16, of the reply brief.

skill in the art would not have considered the wide, relatively shallow, reduced diameter segments of Shiba's roller delineated by the smaller diameter portions 104 as constituting "slots" within either the generally accepted meaning of that word,[4] or the meaning of the claim term "slot" when it is read in light of appellant's disclosure.[5]

On this basis, we are constrained to reverse the standing rejection of claims 21 and 26 as being unpatentable over Shiba.

New Grounds of Rejection

Regarding the issue of anticipation of a claim by a prior art reference, we are guided by the following principles. Anticipation does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). Additionally, the law of anticipation does not require that the reference teach what

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[4]The noun "slot" may mean "[a] long narrow groove, opening or notch. . . ." *Webster's II New Riverside University Dictionary,* The Riverside Publishing Company, copyright © 1984 by Houghton Mifflin Company.

[5]See, for example, page 6, lines 9-12 of appellant's specification, as well as element 20 in Figure 3.

appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). If a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. *See, e.g., In re Schrieber,* 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

In light of the foregoing, and pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejections.

Claim 21 is rejected under 35 U.S.C. § 102(b) as being anticipated by each of Dow, King, Graham, Folden and Neuhauser.

In Dow, temple-roller "a" comprises a tubular wall having an inner surface defining a bore, and an outer surface interrupted by an unnumbered groove or notch that subdivides the outer surface into a plurality of core segments. Thus, template-roller "a" meets all the structural limitations found in the body of claim 21. Further, Dow's temple roller constitutes a "core" as broadly set forth in the preamble of claim 21 in that it is fully capable of functioning, without modification, as a core within the generally accepted meaning of that term notwithstanding that Dow relates to

an entirely different field of endeavor than that of appellant's device and may be directed to an entirely different problem from the one addressed by the appellant in the present case.[6] Hence, claim 21 "reads on" Dow's template-roller such that claim 21 is anticipated by Dow.

In a similar fashion, claim 21 is anticipated by adaptor 401 illustrated in Figure 5 of King, liner 24 best illustrated in Figure 7 of Graham, coupling 32 of Figure 6B of Folden, and liner element 14 of Neuhauser. More particularly, in King, sleeve 401 has an inner surface 408 defining a bore 405 and an outer surface 406 interrupted by grooves 410 that defines a plurality of core segments; in Graham, liner 24 comprises a tubular wall having an inner surface defining a bore 96 and an outer surface interrupted by grooves 98 that define therebetween a plurality of core segments; in Folden, coupling 32 has an inner surface defining a bore and an outer surface divided into core segments by scoring notch 38; and in Neuhauser, liner element 14 has an inner surface

[6]The manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. *See, for example, In re Yanush,* 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 1032, 168 USPQ 530, 534 (CCPA 1971); *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

defining a bore and a plurality of annular or circumferential grooves 18 distributed along its length (column 2, lines 55-57) to define a plurality of core segments along the outer surface of the liner element. Thus, adaptor 401 of King, liner 24 of Graham, coupling 32 of Folden, and liner element 14 of Neuhauser meet all the structural limitations found in the body of claim 21. Further, each of the above enumerated prior art devices constitutes a "core" as broadly set forth in the preamble of claim 21 in that each is fully capable of functioning, without modification, as a core within the generally accepted meaning of that term notwithstanding that each prior art device relates to an entirely different field of endeavor than that of appellant's device and may be directed to an entirely different problem from the one addressed by the appellant in the present case. Hence, claim 21 "reads on" adaptor 401 of King, liner 24 of Graham, coupling 32 of Folden, and liner element 14 of Neuhauser such that claim 21 is also anticipated by King, Graham, Folden and Neuhauser.

Claim 26 is rejected under 35 U.S.C. § 102(b) as being anticipated by each of Dow, Graham and Folden.

Based on the showing in the drawings of Dow and Graham,[7] the unnumbered groove or notch in the temple-roller of Figure 2 of Dow and the grooves 98 in the liner of Figure 7 of Graham comprise slots that extend into the core to a depth such that the webs formed by the slots are thinner that the slots are deep. As to Folden, attention is directed to column 6, lines 36 to 45, where the depth of the scoring notch 38 relative to the wall thickness of the coupling results in a slot depth and core web thickness that satisfy the requirements of claim 26.

Appellant's arguments in the main and reply briefs directed to claims 21 and 26 have been considered with respect to the new rejections entered above. The argument directed to the issue of non-analogous art is simply not germane to the new rejections since they are anticipation rejections made under 35 U.S.C. § 102. *In re Schrieber,* 128 F.3d at 1478, 44 USPQ2d at 1432; *In re Self*, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (CCPA 1982).

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[7]A drawing is available as a reference for all that it teaches a person of ordinary skill in the art. *In re Meng*, 492 F.2d 843, 847, USPQ 94, 97 (CCPA 1974). Hence, a claimed invention may be anticipated by a drawing even if its disclosure is accidental. *Id.* Although patent drawings usually are not working drawings, features that are clearly shown cannot be disregarded even if such features are unexplained by the specification. *In re Mraz*, 455 F.2d 1069, 1072, 173 USPQ 25, 27 (CCPA 1972).

Appellant's argument in the reply brief that the preamble term "core" is a positive limitation that breathes live and meaning into the claims has been considered with respect to the new rejections entered above. The question of when the introductory words of a claim, the preamble, constitute an additional structural limitation of the claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. *See Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-82 (CCPA 1951). In the present case, the description of the core found at page 4, line 12, through page 5, line 13, of appellant's specification indicates that the core may take on any number of suitable forms. Based on this disclosure, we do not perceive the preamble recitation "core" of claims 21 and 26 as requiring any particular structural or functional relationship of the components of the claimed core above and beyond those found in the body of the claims. Rather, the portion of the claims following the preamble is a self-contained description of the appellant's invention not depending for completeness upon the introductory clause. Accordingly, it is our

view that the preamble of the appealed claims does not constitute a limitation of the claims.

We also note appellant's contention on page 7 of the reply brief that the recited "core" is a term of art; however, we are appraised of no persuasive evidence of record to support appellant's contention. It is well settled that an attorney's argument in the brief cannot take the place of evidence and that arguments of counsel, unsupported by competent factual evidence of record, are entitled to little weight. *See In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979) and *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

For the above reasons, the newly entered anticipation rejections of claims 21 and 26 are proper.

Conclusion

The examiner's rejection of claims 21 and 26 as being unpatentable over Shiba is reversed.

New rejections of claims 21 and 26 have been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "[a] new grounds of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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